

### **REMARKS/ARGUMENTS**

In the Office Action dated February 22, 2010 (hereinafter, "Office Action"), claims 1-4, 6-11, 13-21 and 23-28 were rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 7, 11, 13, 17, 24 and 28 are being amended.

Applicant respectfully responds to the Office Action.

#### **I. Claims 1-3, 6, 8-11, 14-20, 23 and 25-28 Rejected Under 35 U.S.C. § 103(a)**

Claims 1-3, 6, 8-11, 14-20, 23 and 25-28 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,466,329 to Mukai (hereinafter, "Mukai") in view of U.S. Patent Application Publication No. 2003/0002068 to Constantin et al. (hereinafter, "Constantin"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Independent claim 1 has been amended to recite that "the document formatting inputs comprise copy function options usable with the scan job, the copy function options controlling the page orientation, page margins, and page size of the scan job." Independent claim 1 has further been amended to recite that the "page description language [created based on the document format inputs] ... indicates the page size, the page margins, and the page orientation of the scanned image data."

Support for this claim subject matter is found in paragraphs [61] and [72] of the filed specification. As noted previously, Applicant's claim 1 enables a device to "treat a scan job as a copy job with an electronic output instead of paper." (Specification, paragraph [67].) For example, "[w]hen the user initiates a scan, the user is able to use the copy functions of the control panel of the imaging device 120 to specify how the image data is to be document formatted" (Specification, paragraph [67]) and more specifically, the present claim 1 allows a scanned image to be encapsulated in a page description language that indicates the page size, the page margins, and the page orientation of the scan job (claim 1).

The combination of Mukai and Constantin fails to teach or suggest that "the document formatting inputs [that create the page description language] comprise copy function options usable with the scan job ... [and that] the page description language that is transmitted indicates the page size, the page margins, and the page orientation of the scanned image data," because the cited references do not teach using copy controls with a scan job to produce a scanned image encapsulated with PDL format data indicating the page size, margins, or orientation of the scanned image. With respect to Mukai, this reference teaches a system in which a scanned image may be obtained and "enclosed in PDL format" (Mukai col. 9, lines 31-44) and that a scanned image may be "transfer[red] to the database server" (Mukai col. 7, lines 19-22). As acknowledged by the Office Action, Mukai does not teach the use of copy functions with a scanning process. (Office Action, page 4). Thus, to the extent that Mukai indicates the use of a PDL format for a scan job, there is no indication that this PDL data for a scanned image is based upon inputs received from copy controls, as taught by claim 1. Perhaps more significantly, there is no indication in Mukai that such PDL format data indicates the page margins, size and orientation of the scanned image data, as recited by amended claim 1. For example, Mukai indicates that control panel 500 may allow an operator to "input various settings and operation commands for copying, printing, facsimile, and document filing operations" and that such commands may include the "number of copies, the size of the copies, the degree of

enlargement/reduction, duplex printing, and master-page printing, as well as setting of the recipient of a facsimile transmission or file transfer of a document.” (Mukai: Col. 9, Lines 36-44). It is significant to note that “scanning” is not mentioned in this list of functions that may receive the delineated user inputs. Moreover, there is clearly no indication that inputs regarding page orientation or margins could be used with a scan job encapsulated into PDL format, and then transmitted. For this reason, Mukai fails to teach or suggest that “the document formatting inputs [that create the page description language] comprise copy function options usable with the scan job... [and that] the page description language that is transmitted indicates the page size, the page margins, and the page orientation of the scanned image data,” as required by amended claim 1.

With respect to Constantin, this reference teaches that a user may “requir[e] that a document be scanned using predetermined copier settings (such as brightness, contrast, resolution, graphic, text, or combined graphic and text image).” (Constantin, paragraph [0026]). To the extent that this reference indicates that copier functions may be used with a scan job, this reference does not indicate that the copy functions are used to provide PDL data that indicates the page margins, size and orientation of the scanned image. Notably, there is no indication in Constantin that the copier settings will be used to define the page orientation or page margins of the scan job. The “copier settings” listed in Constantin omit any indication of controlling the scanned image’s orientation or margins, nor does Constantin explain how such an adjustment of the margins or orientation of the scanned page could be accomplished via copier settings. Simply put, there is no indication of a page description language based upon inputs from copy controls related to the page size, margins, and orientation of the scanned image. For this reason, Constantin fails to teach or suggest that “the document formatting inputs [that create the page description language] comprise copy function options usable with the scan job ... [and that] the page description language that is transmitted indicates the page size, the page margins, and the page orientation of the scanned image data,” as required by amended claim 1.

For at least the foregoing reasons, Applicant respectfully submits that amended claim 1 is allowable. Claims 3, 6, 8-10 and 28 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Further, with respect to amended claim 28, this dependent claim has been amended to recite that the “page description language indicating the page size, the page margins, and the page orientation that is transmitted is identical to that which would have been obtained if the original operation was a copy job instead of a scan job.” The Office Action stated that

[i]f the Applicant would like to distinguish over the prior art of record, it is recommended that the claim be amended to include further detail as to what aspects of the transmitted PDL are identical between the two different modes.

Office Action, page 11. As a result of this paper, claim 28 has been amended to recite that the “page size, the page margins, and the page orientation” are “identical to that which would have been obtained if the original operation was a copy job instead of a scan job.” Applicant submits that such claim subject matter is allowable as there is nothing in the cited references that teaches having PDL data indicating the page size, the page margins, and the page orientation be identical to that which would have been obtained had a copy job been used rather than a scan job. Favorable consideration is respectfully requested.

Amended claim 11 recites that “the document formatting inputs [that create the page description language] comprise copy function options usable with the scan job ... [and that] the page description language indicates the page size, the page margins, and the page orientation of the scanned image data.” As discussed above, the combination of Mukai and Constantin does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 11 is allowable. Claims 14-16 depend from claim 11, and are therefore allowable for at least the same reasons as claim 11.

Amended claim 17 recites that “the document formatting inputs [that create the page description language] comprise copy function options usable with the scan job ... [and that] the page description language that is transmitted indicates the page size, the page margins, and the page orientation of the scanned image data.” As discussed above, the combination of Mukai and Constantin does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 17 is allowable. Claims 18-20, 23 and 25-27 depend from claim 11, and are therefore allowable for at least the same reasons as claim 11.

## **II. Claims 4 and 21 Rejected Under 35 U.S.C. § 103(a)**

Claims 4 and 21 stand rejected under 35 U.S.C. § 103(a) based on Mukai in view of Constantin further in view of U.S. Patent Application Publication No. 2002/0114021 to Lavender et al. (hereinafter, “Lavender”). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 4 depends from claim 1. Claim 21 depends from claim 17. As discussed above, Applicant respectfully submits that claims 1 and 17 are allowable. Accordingly, Applicant respectfully submits that claims 4 and 21 are allowable for at least the same reasons as presented above in connection with claims 1 and 17, respectively.

## **III. Claims 7, 13 and 24 Rejected Under 35 U.S.C. § 103(a)**

Claims 7, 13 and 24 stand rejected under 35 U.S.C. § 103(a) based on Mukai in view of Constantin further in view of U.S. Patent No. 5,493,634 to Bonk et al. (hereinafter, “Bonk”). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

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Claim 7 depends from claim 1. Claim 13 depends from claim 11. Claim 24 depends from claim 17. As discussed above, Applicant respectfully submits that claims 1, 11 and 17 are allowable. Accordingly, Applicant respectfully submits that claims 7, 13 and 24 are allowable for at least the same reasons as presented above in connection with claims 1, 11 and 17, respectively.

### **CONCLUSION**

In view of the foregoing, Applicant respectfully submits that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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